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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/855,337 | 05/15/2001 | Hirotaka Uchiyama | 8085 | 1086 |

27752 7590 03/27/2006

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| EXAMINER | |
|---|---|
| CHANNAVAJJALA, LAKSHMI SARADA | |
| **ART UNIT** | **PAPER NUMBER** |
| 1615 | |

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/855,337 | UCHIYAMA ET AL. | |
| | Examiner | Art Unit | |
| | Lakshmi S. Channavajjala | 1615 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-14,16 and 18-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14,16 and 18-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

Receipt of amendment and remarks dated 1-5-06 is acknowledged.

Claims 15 and 17 have been canceled. Claims 1-14, 16 and 18-58 are pending.

The following is a new rejection applied to the pending claims:

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14, 16 and 18-58 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-10 of U.S. Patent No. 6,878,695 in view of US 5,942,217 ('217) and US 5,879,666 ('666). Although the conflicting claims are not identical, they are not patentably distinct from each other because instant process of preparing the functionally available cyclodextrin containing composition involves the same steps, claimed by the above processes i.e., mixing the compatible and incompatible surfactants, followed by addition of

cyclodextrins. With respect to the instant "functionally available" cyclodextrin, the above patent defines cyclodextrin to be functionally available and complexed with weakly complexing molecules having complexation constants in the range disclosed as well as claimed (col. 5, L 57-67). Thus, the cyclodextrin of instant and patented claims are of the same scope. Patented claims differ from that of instant in the absence of "molecular aggregates". However, applicants admitted that according to instant invention it is the order of mixing the components of the composition i.e., mixing both the surfactants (compatible and incompatible) to form a first mixture resulting in the formation of molecular aggregates and subsequently combining cyclodextrin with the first mixture. Therefore, due to the very process of adding the components of the composition, the formation of molecular aggregates result. Further, the surfactants (compatible and incompatible) claimed by the above patents include all of the claimed as well as the described surfactants of the instant application. Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to use the process of the patented claims to prepare cyclodextrin composition resulting in formation of molecular aggregates of cyclodextrin incompatible surfactants and employ the composition for effective and efficient capture of unwanted odor molecules.

Patent '217 teach compositions comprising uncomplexed cyclodextrin for absorbing odor from inanimate surfaces, particularly from clothes, fabric (col. 1, col. 3, lines 56-63; and cols. 6-8). Woo describes the same uncomplexed cyclodextrins as that of instant invention. Woo also teaches inclusion of cyclodextrin compatible surfactants along with uncomplexed cyclodextrins for absorbing the odors from fabrics, inclusion of

antimicrobial compounds such as betaines, quaternary ammonium compounds etc., in the cyclodextrin composition (paragraph bridging col. 13-14) for their antimicrobial action. Patent '666 is also directed cyclodextrin containing composition for the same use i.e., capturing molecules of unwanted odor from human skin, hair or from inanimate surfaces. The '666 patent teach the specific castor oil surfactant claimed and also citric acid buffering agent. Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to add antimicrobial compounds, specific surfactants, buffering agents (of '217 and '666 patents) in the composition of '695 patent with an expectation to preserve the composition from microbial growth as well as stabilize the composition. Further, optimizing the amounts of the active agents and excipients so as to achieve the optimum efficiency in capturing unwanted molecules in the composition of '695 would have been within the scope of a skilled artisan. Furthermore, optimizing the amounts of the components such as cyclodextrin, surfactants, incorporation of buffering agents and antimicrobial agents.

Claims 1-14, 16 and 18-58 are directed to an invention not patentably distinct from claims 6-10 of commonly assigned US 6,878,695. Specifically, as explained above, the compositions and process of making the instant composition is obvious over that of the patented claims.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned US 6,878,695, discussed above, would form the

basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Response to Arguments***

Applicant's arguments with respect to claim1-14, 16 and 18-58 have been considered and are found persuasive. Accordingly, examiner has withdrawn the following rejections made previously of record:

Claims 1-16, 18-30, 33-43, 49, 51 and 53-55 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,879,666 to Lucas et al (Lucas) or US 5,874,067 to Lucas et al (Lucas).

Claims 44, 50, 52 and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,879,666 to Lucas et al (Lucas) or US 5,874,067 to Lucas et al (Lucas) in view of US 5,942,217 to Woo et al (Woo).

Claims 17, 31, 32 and 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,879,666 to Lucas et al (Lucas) or US 5,874,067 to Lucas et al (Lucas).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -6.30 PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lakshmi S Channavajjala
Examiner
Art Unit 1615

March 20, 2006